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EXAMINER
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GARG, YOGESH C

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3625

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/864,113  
Filing Date: May 24, 2001  
Appellant(s): GUSLER ET AL.

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Robert H.Frantz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 09/15/2006 appealing from the Office action mailed 6/21/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct conforming to 37 CFR 41.37(c)(1)(v) because it includes : (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters (see Appeal Brief page 2,

line 11—page 3, line 17, “ More specifically, independent Claim 1 sets forth a method.....(d) a shopper associator adapted to automatically associating .....meeting the criteria (para.[0052]).).

However, the applicant's interpretation and arguments given under the **“Summary of Claimed Subject Matter”**, in the Appeal Brief (page 2, lines 6-10, *“and they are not previously part of a group or association (e.g. they have not joined an introduction association such as a dating site). Accordingly, our claims to specify that the two shoppers who are automatically introduced to each other via the invention while using or visiting a same shopping web site at the same time, and that they were “previously disassociated” with each other “)* neither represent the claimed invention nor is supported by the applicant's disclosure. Because the recited limitations in independent claims 1, 10 and 19 do not include a limitation argued by the applicant that is, *“and they are not previously part of a group or association (e.g. they have not joined an introduction association such as a dating site)”*. The applicant's disclosure nowhere defines that the two shoppers previously disassociated means -- *they are not previously part of a group or association (e.g. they have not joined an introduction association such as a dating site)”*. The figure 8 and paragraphs 0031-0032, 0052, 0056-0058, 0064 do not support the applicant's above cited interpretation and argument regarding claims 1, 10 and 19.

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

6,349,327	TANG et al.	2-2002
6,381,583	KENNY	4-2002

"Surfing; [Cook/Dupage/Fox Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 and Odigo.com web pages of May 10, 2000 captured via the WayBackMachine (archive.org) and hereafter collectively referred to as "Odigo".

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims: The ground(s) for rejection are reproduced below from the Non-Final Office Action mailed on 6/21/2006 for the convenience of both the Appellant and the Board of Patent Appeals:

Quote:

#### ***Response to Arguments***

2. In the Appeal Brief, appellant argues at page 5 - 9 that Odigo does not teach or disclose the claim limitation of "otherwise disassociated". The examiner respectfully disagrees.

First and of note, the Appellant arguments focus only on the meaning of the phrase "otherwise disassociated" and specifically the meaning of the word "disassociated". In that regard and as noted in the Final Rejection at page 9 and 10, the Appellant did not specifically define nor even use the word "disassociated" in the their specification. In that regard and in a reasonably broad interpretation of the word "disassociated" and as defined by Merriam-Webster's Dictionary - "as detached from association", Odigo would teach that one online user/shopper is "detached" from another when the new friend/user/shopper is not aware of nor even know the other user/shopper previously - or is even that the other user/shopper is online. Moreover in the Applicant's specification examples, AOL buddies can add new friends to their list. In order for these two "new" friends to communicate via AOL Instant messaging with the others - they must have the same software (i.e. AOL Instant Messaging) to communicate and thereby are associated in the AOL Instant Messaging community (see at least Para 0031 and Para 0056). In this case, Odigo members/users/shoppers can introduce themselves to a fellow Odigo user/shoppers, who they are not currently associated with - since new user/shopper/friend does not know the other as well as the "new" user/shopper is not even aware that the other user/shopper is online. For example, Odigo would teach one of ordinary skill the capability to through "PeopleFinder" new friends and introduce oneself to another user/new friend/shopper- that currently does not know them or is even aware that they are on the internet (Page 1, 3-5 and 11-13). Thereby and prior to the introduction, the new users/shopper/friend is "detached" and "otherwise disassociated" from the other user/shopper.

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Second, the independent claims are excessively broad and vague especially in light of the word "disassociated". While the Appellant attempts to redefine his meaning of the phrase "otherwise disassociated" and specifically the word "disassociated" by comparing to the word associated at pages 6 and 7, the specification as originally filed does not contain any disclosure or explanation of the phrase. Moreover, the Appellant's specification does not even contain the word "disassociated". Thereby, it forces one of ordinary skill in the art to simply speculate exactly what "disassociated" and thereby the phrase "otherwise disassociated" means, which makes determining the metes and bounds of the claim almost impossible. In this case and as noted above, an interpretation regarding the word "disassociated" and thereby the phrase "otherwise disassociated" was interpreted and this interpretation was - that the shoppers were disassociated with each other until an one on line shopper notifies the other of their presence (Odigo pages marked 5, 7 and 9). Turning to the claims, it is noted that online shopper must also be "using" a "common" virtual shopping resource and thereby the online shoppers are "associated" (i.e. the opposite of disassociated) but somehow and left to the reader's speculation and wonderment is exactly how they are "otherwise disassociated". While the Appellant at page 8 attempts to have it both ways - whereby the online shoppers are "associated" at a common virtual shopping resource but are "otherwise disassociated", this tortured explanation by the Appellant is contradictory (i.e. associated but not associated) and thereby adds to the confusion and speculation of interpreting the phrase "otherwise disassociated" and especially the word "disassociated". Furthermore and in contrast and contradicts Appellant's arguments, the specification at Para 0056, last sentence states that "one set of criteria maybe that the detected shopper must already be on the shopper's buddy list", which clearly indicts that these individuals are associated previously - the opposite of "disassociated". Therefore and as noted in the Final Rejection, Odigo teaches a method and system for providing enhanced online shopping experiences to online shoppers for automatic association of two or more online shoppers, said method comprising the steps of: searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other (see at least pages 1 - 8 and 11 - 13); notifying a first online shopper that at least one other concurrently online shopper meets said search criteria; and automatically associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least pages 1 - 2 and 7 - 9).

Appellant argues at page 9 and 10 of the brief that the public was not in possession of Invention and that Surfing and Archive do not provide enabling disclosures. With respect to the public being in possession of the Odigo, the reference clearly teaches that the public as well as potential partner(s) can download the software and use Odigo software. For example, the reference teaches that the software had been downloaded and evaluated (see at least pages 1 - 2). Moreover, the Odigo teaches that Partner's such as "StarMedia Network" has implemented and is using Odigo software (page 5) and thereby teaches that Odigo was clearly in Public use with a key partner. With respect to providing an enabling disclosure, it is noted that the reference as whole teaches that the Odigo software is clearly enabled - since it is in use by partners as well as individual user's and the functions of the software are also disclosed. In addition and as noted in the decision of *Fonar Corp v. General Electric Co.*, 41 USPQ2d 1801, 1805 - "As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed.... [F]low charts or source code listings are not a requirement for adequately disclosing the functions of software."

Appellant argues at page 9 that the combination of Surfing and Archive into a single reference under 35 USC 102 is improper. While the Appellant asserts that the combination of the Surfing and Archive is improper for a 102 rejection, the Appellant does not cite any reference such as the MPEP or Court cases, which clearly detail that combining NPL references is not proper. In this case and as noted by the MPEP (2131.01), Multiple references can be used for a 102 Rejection, whereby the primary reference "Surfing" contains an "enabled disclosure", which "Archive" discloses.

In view of the foregoing, the rejection of claims 1, 3, 4, 8, 9, 10, 12, 13, 17, 18, 19, 21, 22, 26 and 27 under 35 U.S.C. 102(b) as being in public use as evidenced by "Surfing; [Cook/Dupage/Fox

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Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 and Odigo.com web pages of May 10, 2000 captured via the WayBackMachine (archive.org) and hereafter collectively referred to as "Odigo", is sustainable.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 8, 9, 10, 12, 13, 17, 18, 19, 21, 22, 26 and 27 are rejected under 35 U.S.C. 102(b) as being in public use as evidenced by "Surfing; [Cook/Dupage/Fox Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 and Odigo.com web pages of May 10, 2000 captured via the WayBackMachine (archive.org) and hereafter collectively referred to as "Odigo".

Please note that each of the NPL documents pre-date the filing of the applicant's invention by 1 year.

Regarding Claim 1 and related claims 10 and 19 (previously amended), Odigo teaches a method and system for providing enhanced online shopping experiences to online shoppers for automatic association of two or more online shoppers, said method comprising the steps of: searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other (see at least pages 1 - 8 and 11 -13); notifying a first online shopper that at least one other concurrently online shopper meets said search criteria; a associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least pages 1 - 2 and 7 - 9).

Regarding Claim 3 and related claims 12 and 21 (original), Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper name criteria (Page 5 and 9).

Regarding claim 4 and related claims 13 and 22, Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position criteria (Page 7).

Regarding claim 8 and related claims 17 and 26, Odigo teaches a method wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises establishing a communications session between said online shoppers (Pages 7 and 11).

Regarding claim 9 and related claims 18 and 27, Odigo teaches a method wherein said step of establishing a communications session between said online shoppers further comprises making a record of said communications session (pages 7 and 11). Please note that Odigo does not specifically disclose recording the communication session. However, it is old and well known that these chat/communications sessions can and are saved in a database, which is effectively a recording. In this manner, the individuals will be able at a later to review their online chat sessions as necessary.

4. Claims 1, 3, 4, 8, 9, 10, 12, 13, 17, 18, 19, 21, 22, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Odigo.

Regarding Claim 1 and related claims 10 and 19 (previously amended), Odigo teaches a method and system for providing enhanced online shopping experiences to online shoppers for automatic

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association of two or more online shoppers, said method comprising the steps of: searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other (see at least pages 1 - 8 and 11 -13); notifying a first online shopper that at least one other concurrently online shopper meets said search criteria; a associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least pages 1 - 2 and 7 - 9).

Regarding Claim 3 and related claims 12 and 21 (original), Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper name criteria (Page 5 and 9).

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Regarding claim 9 and related claims 18 and 27, Odigo teaches a method wherein said step of establishing a communications session between said online shoppers further comprises making a record of said communications session (pages 7 and 11). Please note that Odigo does not specifically disclose recording the communication session. However, it is old and well known that these chat/communications sessions can and are saved in a database, which is effectively a recording. In this manner, the individuals will be able at a later to review their online chat sessions as necessary.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5-6, 11, 14-15, 20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odigo as applied to claims 1 and 19 above, and further in view of Tang et al.(US 6,349,327), hereinafter referred as Tang.

Regarding claim 2 and related claims 11 and 20, Odigo discloses and teaches substantially the applicant's invention, as analyzed above with respect to claims 1, 10 and 19. However, Odigo does not specifically disclose and teach a method and system wherein said step of notifying a first online shopper comprises providing a buddy position indicator on a graphical map of an online shopping mall.

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tang in the analogous art discloses a computer-based mechanism used in searching a list of concurrently online workers, who are unaware of each other, according to a set of search criteria [that is a task proximity relationship occurs among these workers based on any of three distinct factors, that is (i) the application the worker is currently using, (ii) the data the worker is



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accessing or manipulating, and (3) the time at which the worker is accessing or manipulating ]. The same computer-mechanism notifies a first work member that at least one other concurrently online worker [both the workers being unaware of each other as regards to their task proximity relationship] meets said search criteria, that is of task proximity and discloses that the step of notifying a first online shopper comprises providing a buddy position indicator graphically on the computer screen if that buddy is working on the same data/manipulating the same data or working on the same application at the same time (see Fig. 1, col.2, lines 38-49, col.3, line 33-col.6, line 5). Tang's art is reasonably pertinent to the particular problem with which the applicant was concerned, that is notifying a worker a buddy position graphically on a graphic screen while working on the same task [ notifying a shopper in the applicant's invention of a buddy position also shopping in proximity but unaware of each other] and these workers are unaware of each other's presence [ disassociated from each other as claimed in the applicant's invention]. In view of Tang, it would have been obvious to one of ordinary skill in the art a the tie of the invention to have provided the method and system of Odigo with the method and system of Tang to have enabled a method and system wherein said step of notifying a first online shopper comprises providing a buddy position indicator graphically/on a graphical map of an online shopping mall because, as explicitly disclosed in Tang (see at least Tang, col.3, lines 47-55), it would enable the shoppers to become aware of each other's proximity, which otherwise on Internet would not be possible, and would facilitate spontaneous interaction such as found in physical environments like shopping malls leading to helping or support each other in their respective shopping tasks.

Regarding claims 5-6 and related claims 14-15 and 23-24, Odigo discloses and teaches substantially the applicant's invention, as analyzed above with respect to claims 1, 10 and 19. However, Odigo does not specifically disclose and teach a method and system wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper interest term criteria or a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position proximity criteria.

Tang in the analogous art, as analyzed for claims 2, 11 and 20 above teaches (see Fig.1, col.2, lines 38-49, col.3, line 33-col.6, line 5) that step of searching a list of concurrently online shoppers [workers in Tang] according to a set of search criteria [criteria of task proximity in Tang] comprises searching by an online shopper interest term criteria [ the worker working/manipulating same data/application at the same time ] or a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position proximity criteria [task proximity in Tang]. In view of Tang, it would have been obvious to one of ordinary skill in the art a the tie of the invention to have provided the method and system of Odigo with the method and system of Tang to have enabled a method and system wherein said step of said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper interest term criteria or a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position proximity criteria because it would help to notify the shoppers of each other's proximity, which otherwise on Internet would not be possible, and would facilitate spontaneous interaction such as found in physical environments like shopping malls leading to helping or support each other in their respective shopping tasks.

7. Claims 7, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odigo as applied to claims 1, 10 and 19 above, and further in view of Kenney (US Patent 6,381,583).

Regarding claim 7 and related claims 16 and 25, Odigo discloses and teaches substantially the applicant's invention, as analyzed above with respect to claims 1, 10 and 19. However, Odigo does not specifically disclose and teach a method and system wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises setting position coordinates for both shoppers to equivalent values. On the other hand in the same area of interactive electronic shopping online method and systems and regarding claim, 7 and related claims 16 and 25, Kenney teaches a method and system setting position coordinates for shoppers to equivalent values

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(see at least col.2, lines 40-65, col.8, lines 17-57, col.9, lines 34-56 and col.10, lines 37-52. Kenney's invention, in the same field as that of Odigo, discloses shoppers carrying out online interactive electronic shopping and while traveling/navigating through a shopping area, such as a store, the system continuously keeps a track of the location of a shoppers and their movements by tracking their cursors. Computer programming is used to define or to set position coordinates for the shoppers with preset spatial parameters that define the range of x-y-z coordinates to be shown at any given cursor location, which is indicative of a shopper's location in the shopping area). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided Odigo with the a method and system of Kenney to have enabled a method and system wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises setting position coordinates for both shoppers to equivalent values because, as explicitly disclosed and discussed in Kenney (see at least col.2, lines 40-65, col.8, lines 17-57, col.9, lines 34-56 and col.10, lines 37-52) it would enable Odigo's method and system would help to identify the position of shoppers precisely in a shopping area which would further enhance the Odigo's method and system in searching and identifying shoppers shopping in the same area and making them aware of each other for the obvious reasons of providing them an opportunity to interact, which otherwise they could not have done. The advantages of interacting while shopping at the same place at the same time are already discussed while analyzing claims 2, 11 and 20. "

Unquote:

**(10) Response to Argument:****A. Rejection of Claims 1,3-4,8-10, 12-13,17-19,21-22,26-27 over Odigo references, " "Surfing" and "Archive".**

The applicant's arguments ( pages 5-9) are directed to the interpretation of the term, " otherwise disassociated" in the independent claims 1, 10 and 19 the examiner response is directed to the discussion of the term , " otherwise disassociated" recited in independent claims 1, 10 and 19.

The applicant argues that Odigo does not teach all the claimed elements and limitations in claim 1 because Odigo does not conform to the definition of " Previously Disassociated" as provided and argued by the applicant in the Appeal brief, page 5, line 14-page 9 line 25. The examiner respectfully disagrees for the following reasons:

The applicant's disclosure (see the PG-PUB of the applicant's application 20020178072A1, Fig..8, paragraphs 0031-0032, 0052, 0056-0058, 0064, as mentioned

by the applicant in the Appeal Brief under the head, "**Summary of Claimed Subject Matter**") teaches (i) enabling a shopper to become aware of another concurrently shopping buddy so that they can communicate and chat with each other about the product he wants to purchase (ii) and in another embodiment (see paragraphs 0063-0064) enables meeting of two unknown concurrently shopping shoppers in an online shopping mall having obvious mutual interests such as jazz music or same author allowing them to chat or discuss. The applicant's disclosure and the limitations recited in independent claims 1, 10 and 19 do not disclose the following limitations argued by the applicant in his Appeal Brief:

(a) See Appeal Brief , page 2, lines 1-10 under the head "**Summary of Claimed Subject Matter**".

"This patent application claims a technology useful in online shopping, virtual malls, shopping web site navigation, and particularly technology for providing the ability of two online shoppers to be introduced to each other when they are visiting the same shopping web site, even though they are not previously known to each other (e.g. they are not on each others buddy lists), *and they are not previously part of a group or association (e.g. they have not joined an introduction association such as a dating site)*. Accordingly, our claims specify that the two shoppers who are automatically introduced to each other via the invention while using or visiting a same shopping web site at the same time, and that they were "previously disassociated" with each other ." **Note: The portion in italics, which the applicant has argued as the**

**definition of the term "otherwise disassociated" recited in the claims 1, 10 and 19 is not disclosed in the applicant's disclosure or recited in the claims.**

(b) See Appeal Brief, page 7, lines 13-16).

" In the sense of the first definition, our invention introduces users who have common interests and are commonly surfing a shopping web site, *but who are not organizes with a degree of formality (e.g. they are not members of a group or organization in common such as the Odigo community, AOL community, etc.)*

**"Note: The portion in italics, which the applicant has argued as the definition of the term "otherwise disassociated" recited in the claims 1, 10 and 19 is not disclosed in the applicant's disclosure or recited in the claims.**

(c) See Appeal Brief, page 8, line 23-page 9, line 5.

" The other pages from the Odigo archive are clearly disclosing a "community" of users formed by installing and joining or using the Odigo product. These users have profiles, and even pictures, previously associated with their Odigo member ID numbers. *As such, all users of Odigo are "previously associated" (not previously disassociated) with each other, before they visit a common web site, even if they have not actually communicated with each other yet. For example, there is no disclosure provided by Archive which discloses that Odigo can find users or visitors to a common website who have not previously downloaded, installed, and joined Odigo's community of users, including establishing a "profile".*

Appellants have claimed that the "shoppers" between whom the invention enables communications are visiting "a common virtual shopping resource", and are "otherwise disassociated with each other". ***In other words, they have not previously joined a common chat group, or common community, such as AOL, which would allow them to "find" each other."*** Note: The portion in italics, which the applicant has argued as the definition of the term "otherwise disassociated" recited in the claims 1, 10 and 19 or the term " previously associated" is not disclosed in the applicant's disclosure or recited in the claims.

(d) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the definitions of the term " otherwise disassociated" as argued above in a, b and c above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(e) The applicant has attempted to be his own lexicographer by arguing the meaning of the term " otherwise disassociated" recited in claims 1, 10 and 19 so as to overcome the prior art of Odigo. The applicant or a patentee can act his own lexicographer to specifically define terms of a claim but in such a situation the written description must clearly provide the definition so as to put a reasonable competitor or one reasonably skilled in the art on notice that the applicant or patentee intended to

specifically define the term. However, as analyzed in a, b and c above the applicant has not defined the term , " otherwise disassociated' as argued in his Appeal Brief. See MPEP 2173.05 III. TERMS USED CONTRARY TO THEIR ORDINARY MEANING MUST BE CLEARLY REDEFINED IN THE WRITTEN DESCRIPTION, and MPEP 2111.01 Plain Meaning [R-3] .

MPEP 2173.05 III states : " Consistent with the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer, a patentee or applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly redefines the terms. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ("While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning," in such a situation the written description must clearly redefine a claim term "so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term."); *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990). Accordingly, when there is more than one definition for a term, it is incumbent upon applicant to make clear which definition is being relied upon to claim the invention".

MPEP 2111.01 Plain Meaning [R-3] states:

**I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION:**While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, \*\*>367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)< (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) .....

**II. "PLAIN MEANING" REFERS TO THE ORDINARY AND CUSTOMARY MEAN-ING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART:\*\*>"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the**

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time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, \_\_\_ F.3d \_\_\_, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*).< *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). " *per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.") >and *Vitronics Corp. v. Conception Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)

.....

### III. APPLICANT MAY BE OWN LEXICOGRAPHER

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ..... ("When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description."). See also MPEP § 2173.05(a).<

(f) Keeping in view the above analysis and interpreting the term " otherwise disassociated " in the broadest possible terms Odigo anticipates the limitations of claim 1 as analyzed below:

Regarding Claim 1, Odigo teaches a method for providing enhanced online shopping experiences to online shoppers for automatic association of two or more online shoppers, said method comprising the steps of:

searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other and notifying a first online shopper that at least one other concurrently online shopper meets said search criteria; a associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least page 2 of the "Surfing" article , *" A program called Odigo also lets you post notes associated with a given page, but that's the least of its abilities. Odigo is Internet radar; it finds the Web sites Odigo users are visiting, helps you locate the users you want to chat with at that site and then enables you to chat with them. ... Once at a site, you can bring up a "radar screen" window that shows you which Odigo users are there. Address: [www.odigo.com](http://www.odigo.com) ". Note:*

The searching criteria in Odigo program is to search and locate concurrent Odigo users visiting a web site and then make them aware of each other so that they can chat with each other. Since these users do not about each other till the Odigo program enables them to be aware of each other and chat with each other they are otherwise disassociated. This surfing article is the evidence of the use of an Odigo program and its website :

[www.odigo.com](http://www.odigo.com) , as referred to contains details and enabled disclosure. See page 5,



" Odigo is a powerful real-time communication tool that gives you more than just Chat, Instant Messaging and a Friends List. **Find your dream match with Odigo's People-Finder, or communicate with new friends on any website!** Access buddies and stay in contact with friends on ICQ Messenger. **Track people on a favorite site with Odigo's Homepage.** Or join multi-user chat on any website! ", page 7, " Odigo is an amazing communication tool that succeeds in bringing a world of interesting people from all over the Net right to your computer screen. **Odigo finally makes it possible to interact with people surfing the same site as you are, in real time. And even before you start chatting with someone, you can quickly peek at their profile to check out gender, age, location, and interests, among other details. Even better, you can create a profile of the person you'd like to meet anywhere in the world, and then find your ideal match instantly online.**", page 8, " No, the real reason you can't see your fellow Internauts is that you need a special program that makes them visible on your computer screen. That's what Odigo does. **With its people-finding "radar", Odigo shows you who's surfing on the same site as you - or on any other website - at this very moment. All you have to do is click on any person icon, open a message window, and start chatting. With Odigo, a world of new friends- is just waiting for you to say "hola!",** and page 9, " Find people using Odigo's search engine Odigo members of all ages and with specific interests can be found in any geographically location you want. **Use Odigo's search engine to find exactly a person you want to meet; put together a group with a common interest , like Olympic sports; ....Find fish-lovers; meet musicians; trade recipes with Russians. What have you always wanted to do? ..** ". These disclosures from the Odigo web pages clearly teach that Odigo web site and program execute the steps of searching concurrently online shoppers according to a set of search criteria, such as mutual interests or if they are buddies, said shoppers each contemporarily being a user of a common virtual shopping resource, that is a web site, said shoppers being otherwise disassociated with each

other, that is they are unaware of each other, and notifying a first online shopper that at least one other concurrently online shopper meets said search criteria, and associating said first online shopper with said one or more concurrently online shoppers meeting said criteria by enabling them to chat.

In view of the foregoing, the applicant's arguments are not persuasive and the rejection of claims 1,3,4,8-10,12-13,17-19,21-22 and 26-27 under 35 USC. 102 (b) submitted in the earlier Office action mailed on 6/12/2006 is sustainable.

**B. The Combination of Surfing and Archive into a Virtual Reference Under 35 USC 102 (b) is Improper, reference are not enabling.**

The applicant argues (see page 10, line 19-page 11, line 28) that combining of multiple references constitutes two errors, that is they cannot be collectively referred to by a single, examiner-assigned name or handle and none of the cited references is enabling and none of them teaches all the claimed elements, steps and limitations. The examiner respectfully disagrees for the following reasons:

Examiner has used Multiple references in conformity with MPEP Guidelines 2131.01 Multiple Reference wherein the article "Surfing; [Cook/Dupage/Fox Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 is the primary reference showing the evidence of public use of an Odigo program and providing reference to its website **www.Odigo.com** which contains an enabled disclosure and further functional details as is evidence from the web pages of the Odigo web site. The examiner for convenience sake addressed both the primary and secondary reference as " Odigo "

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but did not attempt to combine the two references to render the applicant's invention obvious. It is already analyzed above that both the references "Surfing; [Cook/Dupage/Fox Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 and the web pages of Odigo web site anticipate all the recited limitations including the term, " said shoppers being otherwise disassociated with each other" .

**C. Rejection of Claims 2, 5-6,11,14-15,20 and 23-24 over Odigo references in view of Tang.**

The applicant's arguments (page 12, lines 2-10) are not persuasive for the same reasons as submitted in heads A and B above.

**D. Rejection of Claims 7, 16, and 25 over Odigo references in view of Kenney.**

The applicant's arguments (page 12, lines 12-20) are not persuasive for the same reasons as submitted in heads A and B above.

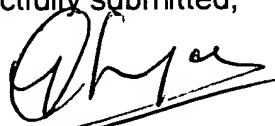
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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Conferees:



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SPE AU3625



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